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EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT PAPER NUMBER

3624

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/609,142

Applicant(s)

FORLAI, LUIGI

Examiner

Narayanswamy Subramanian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 and 62-96 is/are pending in the application.
- 4a) Of the above claim(s) 62-96 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This office action is in response to communication from the Applicants dated July 13, 2004. Amendments to claims 1, 3 and 6, addition of new claims 62-96 and cancellation of claims 16-61 have been entered. Claims 1-15 and 62-96 are currently pending in the application. Claims 62-96 are withdrawn from consideration for reasons given below. Claims 1-15 have been examined. The response to amendment, rejections and response to arguments are stated below.

#### ***Response to Amendment***

2. Newly submitted claims 62-96 are directed to inventions that are independent or distinct from the invention originally claimed for the following reasons:

I. Original and amended claims 1-15 are drawn to a method of making a sale offer over an electronic network system including the step of communicating the randomly generated offer through the electronic network system at an unknown start time for a predetermined duration of time to one or more potential buyers connected to the electronic network system, classified in class 705, subclass 37.

II. Claims 62-82 are drawn to a method of making a sale offer over an electronic network system, including the steps of randomly displaying at least one offer to accept a product or service to a one or more potential recipients on the electronic network system at an unknown start time and receiving an indication of acceptance of the offer from the one or more potential recipients, classified in class 705, subclass 37.

III. Claims 83-96 are drawn to methods of randomly offering discounted products or services over an electronic network system, including the step of displaying an offer to one or more potential recipients on the electronic network system to accept a discounted product or

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service at a price substantially equal to the delivery price of the product or service, classified in class 705, subclass 37.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are related as sub combinations disclosed as usable together in a single combination. The sub combinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I relates to a method of making a sale offer over an electronic network system including the step of communicating the randomly generated offer through the electronic network system at an unknown start time for a predetermined duration of time to one or more potential buyers connected to the electronic network system, whereas invention II relates to a method of making a sale offer over an electronic network system, including the steps of randomly displaying at least one offer to accept a product or service to a one or more potential recipients on the electronic network system at an unknown start time and receiving an indication of acceptance of the offer from the one or more potential recipients. Clearly the step present in one method is not present in the other making the two methods distinct and different. See MPEP § 806.05(d). Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Inventions III and I are related as sub combinations disclosed as usable together in a single combination. The sub combinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I relates to a method of making a sale offer over an electronic network system including the step of communicating the randomly generated offer through the electronic network system at an unknown start time for a predetermined duration of

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time to one or more potential buyers connected to the electronic network system, whereas invention III relates to methods of randomly offering discounted products or services over an electronic network system, including the step of displaying an offer to one or more potential recipients on the electronic network system to accept a discounted product or service at a price substantially equal to the delivery price of the product or service. Clearly the step present in one method is not present in the other making the two methods distinct and different. See MPEP § 806.05(d). Because these inventions are distinct for the reasons given above and the search required for Group III is not required for Group I, restriction for examination purposes as indicated is proper.

Inventions III and II are related as sub combinations disclosed as usable together in a single combination. The sub combinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II relates to a method of making a sale offer over an electronic network system, including the steps of randomly displaying at least one offer to accept a product or service to a one or more potential recipients on the electronic network system at an unknown start time and receiving an indication of acceptance of the offer from the one or more potential recipients, whereas invention III relates to methods of randomly offering discounted products or services over an electronic network system, including the step of displaying an offer to one or more potential recipients on the electronic network system to accept a discounted product or service at a price substantially equal to the delivery price of the product or service. Clearly the step present in one method is not present in the other making the two methods distinct and different. See MPEP § 806.05(d). Because these inventions are distinct for

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the reasons given above and the search required for Group III is not required for Group II, restriction for examination purposes as indicated is proper.

4. Since applicant has received an action on the merits for the originally presented claims, these claims have been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 62-96 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. Applicants in replying to this office action are respectfully advised to cancel the non-elected claims.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites the limitation "at an unknown start time". It is not clear as to whether the start time is unknown to both the seller and the buyer or to the buyer alone. Based on examiner's understanding of the description in the specification, the examiner is lead to believe that the start time is unknown to the buyer but not to the seller. Art rejection of claim 1 is based on this understanding of the claimed invention. Also claims 2-15 are rejected because they are dependent on the rejected claim 1.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claim 2 is rejected under 35 U.S.C. 102(e) as being clearly anticipated by Odom et al (US Patent 6,058,379).

With reference to claim 2, Odom teaches a method for using an electronic network system to facilitate a transaction between a seller and a buyer, said method comprising the steps of: inputting a sale offer parameter for randomly generating at least one sale offer to purchase a product or service (See Odom Column 3 lines 20-26); randomly displaying, through the electronic network system, the at least one sale offer to a selected buyer at an unexpected period of time (See Odom Column 3 lines 20-26 and Column 5 lines 46-50); and withdrawing the display of the randomly generated sale offer in response to an absence of an indication of acceptance of the randomly generated sale offer by the buyer within a predetermined period of time after the step of displaying the randomly generated sale offer (See Odom Column 5 lines 33-38, Column 6 lines 59-63, Column 8 lines 21-23, lines 25-26 and Column 9 lines 65-67). Posting information on the Web and sending e-mail to notify implies displaying at an unexpected period of time. The seller can withdraw at any time at seller's option, which includes

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withdrawing in response to an absence of an indication of acceptance of the offer by the buyer within a predetermined period of time.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 3-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Odom et al (US Patent 6,058,379)

With reference to claims 3, 5 and 6, Odom teaches a method of claim 2 as discussed above. Odom also teaches the steps wherein the step of randomly displaying the at least one sale offer includes displaying the at least one sale offer to a buyer during a plurality of alternative time periods selected by the seller and unknown to the buyer (See Odom Column 5 lines 33-38); wherein the step of randomly generating the at least one sale offer includes the step displaying the at least one sale offer to a buyer over a predetermined period of time determined by the seller and unknown to the buyer (See Odom Column 5 lines 33-38) including the step of displaying the at least one sale offer to a buyer selected by the seller (See Odom Column 5 lines 48-50). Since the seller can list items, modify/remove items, intervene in an exchange at the option of the seller, these steps imply randomness and are known only to the seller and unknown to the buyer. E-mailing to potential purchasers implies displaying the offer to a buyer selected by the seller from a plurality of potential buyers.



With reference to claim 4, Odom teaches a method of claim 2 as discussed above.

Odom does not explicitly teach the step of providing a random frequency device for displaying the at least one sale offer in an unpredictable manner.

Official notice is taken that the step of providing a random frequency device for displaying random offers is old and well known in the art. These devices like pop-up ads generate offers that sometimes results in a sale. This helps the seller increase his/her potential sales without requiring seller intervention.

It would have been obvious to one with ordinary skill in the art at the time of the current invention to combine this step to the disclosure of Odom. The combination of the disclosures taken as a whole, suggests that sellers would have benefited from the potential for increased sales without requiring seller intervention.

With reference to claims 7-15, Odom teaches a method of claim 2 as discussed above further comprising the steps of receiving, through the electronic network system, a first indication of acceptance from the buyer in response to the display of the at least one randomly generated sale offer; displaying at least one term associated with the at least one randomly generated sale offer in response to the first indication of acceptance; receiving a second indication of acceptance from the buyer in response to the display of the at least one term associated with the at least one randomly generated sale offer (See Odom Column 6 lines 28-33 and lines 52-58); displaying at least one payment method option in response to the indication of acceptance; receiving at least one payment method selection from the buyer in response to the display of the at least one payment method option; transferring a sum corresponding to the selected payment method from the buyer to the seller; and requesting delivery of the offered

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product or service to the buyer (See Odom Column 3 lines 43-46). The best bids are displayed to the bidders and the window for making a bid implies opportunities to make repeated bids within a predetermined time. The Clearing process and mechanisms are interpreted to include the steps of displaying at least one payment method option in response to the indication of acceptance; receiving at least one payment method selection from the buyer in response to the display of the at least one payment method option; transferring a sum corresponding to the selected payment method from the buyer to the seller; and requesting delivery of the offered product or service to the buyer. Alternatively these steps are old and well known in the art. These steps help in the speedy and smooth conclusion of the transaction. Odom also teaches the step wherein an offer price substantially equal to a delivery price associated with the sale offer transaction and an offer price substantially equal to a discounted value less than a market value of the offered product or service plus a delivery price associated with the sale offer transaction (See Odom Column 2 lines 7-8). Since the seller sets the selling price, it can be any price including a delivery price or a discounted price. Odom further teaches the steps of withdrawing the at least one randomly generated sale offer in the event the buyer does not indicate acceptance within a predetermined period of time after the step of displaying the at least one randomly generated sale offer (See Odom Column 5 lines 33-38); withdrawing the at least one randomly generated sale offer in the event the buyer does not indicate acceptance within a predetermined period of time after the step of displaying the at least one term associated with the at least one randomly generated sale offer (See Odom Column 5 lines 33-38); and determining if a predetermined monetary amount is available to transfer from the buyer to the seller (See Odom Column 11 lines 22-26).

Odom does not explicitly teach the steps of displaying an acceptance form forming a purchase agreement to the buyer in response to an indication of acceptance from the buyer and receiving an indication of acceptance from the buyer in response to the display of the acceptance form; payment method option comprising a credit card payment option or a cash-upon-delivery payment option; withdrawing the offer in the event the buyer does not indicate acceptance within a predetermined period of time after the step of displaying the acceptance form or a payment method option.

Official notice is taken that these steps are old and well known in the art. These steps provide for smooth negotiations between the buyer and the seller, ensures payment to the seller and helps the seller withdraw the offer in case the buyer is not able to meet the seller's criteria.

It would have been obvious to one with ordinary skill in the art at the time of the current invention to combine these steps to the disclosure of Odom. The combination of the disclosures taken as a whole, suggests that sellers would have benefited from ensuring payment for the transaction and being able to withdraw the offer in case the buyer is not able to meet the seller's criteria and both buyers and sellers would have benefited from the smooth negotiations as a result of inclusion these steps.

11. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Odom et al (US Patent 6,058,379) in view of Smith (US Patent 6,502,076 B1).

With reference to claim 1, Odom teaches a method of making a sale offer over an electronic network system, comprising the steps of: randomly generating an offer to purchase a product or service on the electronic network system (See Odom Column 3 lines 20-26); communicating the randomly generated offer through the electronic network system for a

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predetermined duration of time to one or more potential buyers connected to the electronic network system (See Odom Column 3 lines 20-26 and Column 5 lines 22-25, lines 46-50 and claim 1); completing the sale of the product or service through the electronic network system in response to an acceptance of the offer by a buyer within the predetermined period of time (See Odom Abstract and Column 3 lines 43-46); and removing the offer from the electronic network system should the buyer not accept the offer within the predetermined period of time (See Odom Column 5 lines 33-38, Column 6 lines 59-63, Column 8 lines 21-23, lines 25-26 and Column 9 lines 65-67). Posting information on the Web and sending e-mail to notify implies randomly generating and communicating an offer.

Odom does not explicitly teach the step of an unknown start time to display the offer.

Smith teaches the step of using an internal algorithm to display an offer randomly (See Smith Column 6 lines 52-54, Column 17 lines 17-20).

It would have been obvious to one with ordinary skill in the art at the time of the current invention to combine the disclosure of Smith to the invention of Odom. The combination of the disclosures taken as a whole, suggests that sellers would have benefited from being able to target different buyers by varying the times when the products are offered.

### ***Response to Arguments***

12. Applicant's remarks with respect to claim 1 have been considered but are moot in view of new grounds of rejection.

In support of the official notice taken in claim 4, Examiner would like to provide Smith (US Patent 6,502,076 B1). Smith provides a device for displaying contents to a user in a random

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manner (See Smith Column 6 lines 46-54, Column 17 lines 17-20). This reference is provided in support of the official notice taken and does not constitute new grounds of rejection.

Applicant's other remarks have been considered but are not persuasive.

***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

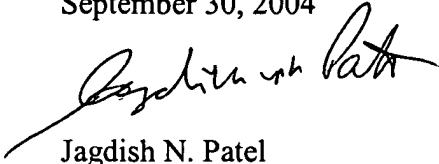
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (703) 305-4878. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065. The fax number for Formal or Official faxes and Draft or Informal faxes to the Patent Office is (703) 872-9306. Any inquiry of

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a general nature or relating to the status of this application should be directed to the Group  
receptionist whose telephone number is (703) 308-1113.

N. Subramanian  
September 30, 2004

A handwritten signature in black ink, appearing to read "Jagdish N. Patel", written over the printed name.

Jagdish N. Patel  
Primary Examiner